

Appln. Serial No. 09/787,397
Amendment After Final Rejection Under 37 CFR 1.116
And Summary Of Telephonic Interview
Docket No. FJIN-107

REMARKS

Claims 14-20 and 22-28 are pending in the application. By this Amendment, Claims 13, 21, and 29 are canceled, without prejudice or disclaimer, and Claims 14-20, 22, and 25 are amended. Support for the claim amendments is found in the specification at, *inter alia*, pages 3-6. No new matter is added by this Amendment.

I. FORMAL MATTERS

Claims 13-29 were rejected under 35 U.S.C. 112, first paragraph, as assertedly failing to comply with the enablement requirement. This rejection is variously obviated and traversed.

Applicants' representative telephoned Examiner Saoud on May 28, 2004 to discuss the pending rejection. In particular, Applicants' representative requested clarification of the rejection of pending Claims 22-28 in view of the Examiner's comments on page 5 of the Office Action that methods directed to the adipogenesis inhibitory effect of stanniocalcin are enabled by the specification.

During the telephone interview, Examiner Saoud stated that Claims 22-28 would receive favorable consideration. In addition, Applicants have amended Claims 22 and 25 in accordance with the Examiner's suggestion to recite a human (Claim 22) or an animal (Claim 25) "in need of adipocyte inhibiting activity". Thus, one of ordinary skill in the art would be able to practice the claimed methods for inhibiting adipocyte activity. Accordingly, the requirements of 35 U.S.C. 112, first paragraph, are satisfied.

Regarding Claims 13, 21 and 29, Applicants maintain that one of ordinary skill in the art would appreciate that the determination of adipogenesis inhibitory activity using mouse preadipocytic cell strain 3T3/L1 as in Example 2 on pages 12-13 of the specification provides a reasonable correlation between: (1) the inhibition of adipocyte

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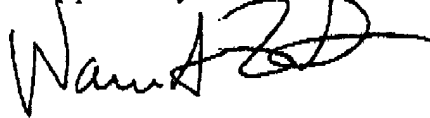
activity as measured by triglyceride accumulation and (2) the treatment of obesity. Nevertheless to advance prosecution, Claims 13, 21, and 29 are canceled and Claims 14-17 and 19-20 are amended to depend from Claim 22. Reconsideration and withdrawal of the rejection are respectfully requested.

II. CONCLUSION

In light of the foregoing remarks, this application is in condition for allowance, and early passage of this case to issue is respectfully requested. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application.

Any fees should be charged to, or any overpayment in fees should be credited to, Deposit Account No. 501032 (Docket #FJIN-107).

Respectfully submitted,



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